

123

AF
1770

IN THE UNITED STATES OF AMERICA
PATENT AND TRADEMARK OFFICE

In re the application of: Howard Lincecum

Atty Doc. #: 94478-00

Serial No.: 09/775,451

Examiner: Aughenbaugh, W.

Filed: 02/01/01

Group: 1772

For: Three-Layer Furniture Bag

Mail Stop APPEAL BRIEF-PATENTS

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FEB 24 2004

CERTIFICATE OF MAILING

Date of Deposit: February 12, 2004

I hereby certify that the following attached paper or fee:

- Reply to Examiner's Answer (Paper No. 17) - in triplicate (5 pgs.); and
- Stamped, return postcard;

is being deposited with the United States Postal Service on the date indicated above and is addressed to
Mail Stop APPEAL BRIEF-PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA
22313-1450.

Tina G. Matz

Tina G. Matz



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Howard Lincecum

EXAMINER: Aughenbaugh, W.

SERIAL NO.: 09/775,451

ART UNIT: 1772

FILING DATE: February 1, 2001

DOCKET NO: 94478-00

TITLE: Three-Layer Furniture Bag

FEB 24 2004

Mail Stop APPEAL BRIEF-PATENTS

Commissioner of Patents

P.O. Box 1450

Alexandria, VA 22313-1450

REPLY TO EXAMINER'S ANSWER (PAPER NO. 17)

Appellant filed an appeal brief on September 16, 2003 in support of the patentability of the above-referenced invention. In reply to Appellant's appeal brief, the examiner submitted an answer dated December 12, 2003, and classified as "Paper No. 17". In light of some of the arguments raised in Paper No. 17, Appellant respectfully requests the Board consider the following remarks:

1. Grouping of Claims.

The examiner contends in his answer that Appellant's claim 11 should not stand or fall on its own. The Examiner alleges, "Appellant has not explained why claim 11 is believed to be separately patentable over claims 1-4, 6-8, 18 and 19." Although Appellant did argue in its appeal brief that claim 11 more clearly defines that the low coefficient of friction layer is the layer in contact with the furniture, the examiner dismissed this complaining that claim 11 does not recite that the bag is in contact with the article of furniture (see Paragraph 7, Page 3 of Paper No. 17).

Contrary to the examiner's position, Appellant does establish the separate patentability of claim 11. Appellant writes in the appeal brief that "[b]y reciting an article of furniture with the dual surface bag of the present invention covering the furniture, claim 11 more clearly defines that the low coefficient of friction layer is the layer in contact with the furniture" (Paragraph 2, Page 18). While claim 11 does not explicitly recite that the bag "contacts" the item of furniture, such contact is the only reasonable conclusion which can be drawn from the wording of claim 11. Claim 11 recites a plastic bag covering an article of furniture with a lower friction surface on the inside of the bag. This leaves no real question that the low coefficient of friction layer of the bag is what contacts the item of furniture.

The inclusion of an "article of furniture" as an element to claim 11 creates claim coverage for a furniture/bag combination as opposed to only the dual surface bag claimed in claims 1-4, 6-8, 18 and 19. By describing an article of furniture "covered" by a plastic film, with the lower friction side of the film facing or contacting the furniture, claim 11 absolutely distinguishes the invention from Sugimoto et al., which discloses an article covered by a film wherein the high friction side of the film is in contact with the packaged article. Even if the Appeals Board should determine that the bag alone recited in claims 1-4, 6-8, 18 and 19 is not sufficiently distinguishable from Sugimoto et al., claim 11's clear assertion of the lower friction inside bag surface contacting the furniture is a limitation which should render claim 11 separately patentable from the other claims on appeal. Therefore claim 11 should not stand or fall with claims 1-4, 6-8, 18 and 19.

2. Teaching Away of Sugimoto

The Examiner cites time and time again in Paper No. 17 that the operation of the Sugimoto invention is the same as Appellant's invention "in that easy slippage between a surface

of a bag and a surface of an article and grippage between the other surface of the bag and a surface of another article as taught by Sugimoto et al. is achieved by the modified bag in Sugimoto et al." This argument is overly generalized. The Examiner downplays the fact that modifying the Sugimoto as described above would totally defeat the intended functionality of the Sugimoto invention, and is contrary to those problems sought to be overcome by the Sugimoto invention. Sugimoto et al. strives for a film that adheres and grips to an article, while having a slippery outer surface to easily slide into and out of a buffering material.

The inventor in Sugimoto et al. acknowledges that his invention is designed to solve problems associated with packaging articles in traditional low density polyethylene films. The inventor in Sugimoto et al. describes the problems associated with using a low density polyethylene film as "the product value is reduced by scratching of the surface and peeling apart of the paint or plated layer due to the friction between the packaging film and the article at the time of transportation and handling of the article (Sugimoto et al., page 1, col. 38). Modifying the Sugimoto invention to have the same structure as Appellant's invention would require that the Sugimoto invention be configured **in total disregard** of those problems the Sugimoto inventor was attempting to avoid. Yes, the Examiner is correct in stating that one side of the Sugimoto film is for easy slippage and one side is for easy grippage. However, the fact that the outer surface of the Sugimoto invention is slippery is the cornerstone of Sugimoto et al. Without being able to easily slide into and out of a buffering material, the Sugimoto invention would encounter the same problems it was designed to resolve. Appellant has difficulty believing it is obvious to configure an invention in a manner which the inventor expressly states he is trying to avoid.

3. Applicability of *In re Gordon*.

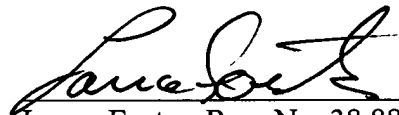
The Examiner's answer also objected to Appellant's assertion that *In re Gordon* was factually similar to the present application. The examiner claimed this was "entirely incorrect" because *In re Gordon* dealt with a blood filter and the present application deals with multilayer bags. However, it should be obvious that Appellant was not asserting that *In re Gordon* dealt with factually the same technology (i.e. multilayer bags). Rather Appellant was asserting that *In re Gordon* dealt with the same facts of an examiner improperly making a rejection based upon reversing the orientation of a prior art device contrary to the prior art device's intended use.

The examiner attempts to distinguish *In re Gordon* by claiming the invention and prior art of *In re Gordon* (blood filtering vs. gasoline filtering) were "completely different intended uses" whereas the examiner asserts Sugimoto and the present invention have the same use. However, the examiner completely misses the point of *In re Gordon*. Nowhere did the *In re Gordon* court attempt to distinguish the invention and prior art on "intended uses." The only reason the *In re Gordon* court gave for finding the prior art reference taught away from the invention was that the prior art taught the reverse orientation employed by the invention. The examiner in this application is falling into exactly the same error as the *In re Gordon* examiner. The examiner in this application is completely reversing the intended orientation of the prior art device in order to conjure up an obviousness rejection. Just as the prior art gasoline filter of *In re Gordon* would not function for its intended purpose when turned upside down, the bag of Sugimoto et al. will not work for its intended purpose (i.e. not slipping against the article inside of the bag) if the bag is turned inside out. The facts of *In re Gordon* are very similar to the present application and *In re Gordon* dictates that the examiner's finding be reversed.

All other arguments made in Appellant's appeal brief remain unchanged, namely: (a) examiner's proposed modification to the multilayer packaging in Sugimoto would render that invention unsatisfactory for its intended purpose, (b) examiner's interpretation and reliance on *Ex parte Masham* is misapplied under the facts of Appellant's case, (c) the examiner's reliance of *In re Japikse* in support of rejecting Appellant's claims is improper, (d) the examiner's proposed modification to Sugimoto would change the principle of the operation of that invention, and thus defeat *prima facie* obviousness pursuant to MPEP 2143.01, and (e) the packaging disclosed in Sugimoto actually teaches away from examiner's proposed modification of Sugimoto. Therefore, Appellant requests the examiner's rejections be reversed.

Respectfully Submitted,

DATE: 12 FEB04


Lance Foster, Reg. No. 38,882
Attorney for Appellant
Jones, Walker, Waechter, Poitevent,
Carrère & Denègre, L.L.P.
4th Floor, Four United Plaza
8555 United Plaza Boulevard
Telephone: (225) 248-2106

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service in an envelope addressed to: **Mail Stop APPEAL BRIEF-PATENTS**, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12th day of February, 2004.

